



"Express Mail" mailing label number: EV 325986401 US

Date of Deposit: April 25, 2007

PATENT
CASE NO. 10022/24

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application:)
)
Perry et al.)
) Group Art Unit: 3623
)
Serial No.: 09/746,611)
) Examiner: C. Michelle Tarae
Filed: December 21, 2000)
)
For: COMPUTERIZED METHOD)
FOR EVALUATING AND)
SHAPING A BUSINESS)
PROPOSAL)

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal is in response to the Final Office Action mailed November 24, 2006 and the Notice of Panel Decision from Pre-Appeal Brief Review mailed on February 23, 2007. The Notice of Appeal was received on January 25, 2007. This Appeal is being filed with a request for a one-month extension of time and accompanying fee.

I. REAL PARTY IN INTEREST

It is believed that Accenture LLP is the real party of interest in this Appeal pursuant to the following: 1) recorded assignments of the above-identified application

to Andersen Consulting LLP by all of the inventors of record, and 2) a recorded Change of Name document that demonstrates that Andersen Consulting LLP legally changed its name to Accenture LLP.

II. RELATED APPEALS AND INTERFERENCES

The undersigned, John R. Lagowski, is not aware of any other appeals, interferences or other judicial proceedings that may be related to, would directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

The status of the claims is as follows:

Claims 2, 5, 6, 9-11, 19-21, and 27 have been canceled.

Claims 1, 3, 4, 7, 8, 12-18, 22-26, and 28-58 are finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,957,191 to Belcsak et al. The rejections under 35 U.S.C. § 103(a) are the subject of this Appeal.

IV. STATUS OF AMENDMENTS

A Final Office Action was mailed on November 24, 2006. No Amendments have been filed from November 24, 2006 to the filing of the present Appeal Brief. A Pre-Appeal Brief Request for Review was filed on January 22, 2007. No other papers have been filed from November 24, 2006 to the filing of the present Appeal Brief.

V. SUMMARY OF CLAIMED SUBJECT MATTER

An understanding of the subject matter of independent claims 1, 18, and 32 can be made upon a review of the embodiments of the invention as follows.

Claims 1 and 18 claim a method of evaluating information to rank (claim 1) or calculate advantages of (claim 18) at least two different business structures between two parties. The information is gathered from at least one database. For example, a centralized database may be routinely updated with information about the businesses of the parties (P. 5, ll. 6-14; P. 16, ll. 10-22). A computer evaluates the information and provides the ranking (or calculated advantages). Claims 1 and 18 are specifically directed at evaluating information to rank at least two of the following possible business structures: alliance, acquisition, equity venture, partnership, and venture (P. 6, ll. 1-8; P. 21, ll. 16-17).

The process includes displaying questions relevant to the possible business structures (P. 11, ll. 27-29; P. 12, l. 29 to P. 13, l. 2; FIG. 9). For example, the questions may relate to the environments, revenue drivers, and risks of the businesses of the parties. The system provides a user access to the centralized database to obtain information to answer the questions (P. 11, l. 29 to P. 12, l. 2; P. 12, ll. 8-15; FIG. 7). The database has information about the parties that is pertinent to the agreement (P. 11, ll. 9-22). In addition, a user may define a query to add criteria for performing a search in the database (P. 13, l. 3). Both the answers to the questions and the query are used to search for information that will provide a basis to automatically evaluate and rank (or calculate advantages of) the business structures (P. 12, ll. 2-4).

The process is iterative and includes at least one reevaluation act (P. 13, ll. 12-13) such as reevaluating the business environment and risk information (FIG. 10).

Claim 32 is directed at a computer system programmed to execute the computerized process discussed above to generate an output for evaluating at least two of the following possible business structures: alliance, acquisition, equity venture, partnership, and venture.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

There is one ground of rejection presented for review: the rejection of claims 1, 3, 4, 7, 8, 12-18, 22-26, and 28-58 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,957,191 to Belcsak et al.

VII. ARGUMENT

With respect to claim 1, the final Office Action states that Belcsak et al. discloses selecting and ranking at least two proposals selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture. This is not a correct reading of Belcsak et al. Although Belcsak et al. mentions the words “merger” and “acquisition”, it does so only to describe a tool that performs calculations for finance operations involved in a merger or finance operations involved in an acquisition.

As discussed below, the finance operations referred to in Belcsak et al. concern a merger or an acquisition that is already underway. Belcsak et al. does not even pertain to selecting between business structures. Teaching a finance tool having calculations for use in merger and acquisition finance operations, as Belcsak et al.

does, does not teach or suggest a method for selecting a type of business structure.

Belcsak et al. does not provide even a hint of a motivation for a modification toward use to select a type of business structure. In sum, the final Office Action is not supported by a correct reading of Belcsak et al.

Belcsak et al. discloses "an automated tool for modeling the cash flows of financial scenarios . . ." col. 1, lines 15 and 16. The Belcsak et al. patent disclosure consists of (a) a description of a system (tool), (b) a description of an interface, and (c) examples of use. In parts of the specification, Belcsak et al. discusses examples of modeling a financial transaction between a lender and a borrower. In other parts of the specification, Belcsak et al. discusses examples of modeling a financial transaction between a lessor and lessee. The examples show how the tool and interface are designed to receive and implement different types of information to create a model of the terms of a financial agreement. See for example the "Qualified Telecommunications Equipment" case (lessor-lessee) from col. 19, line 1 to col. 25, line 34.

The main aspect of Belcsak et al. is discussed at col. 3, lines 36-44:

In accordance with a main aspect of the instant invention, a financial transaction modeling and analysis tool is provided which includes: a graphical user interface which enables a user of the tool to create a graphical model of a financial scenario, generally including at least one financial transaction, on a display screen; and an engine operable, in response to creation of the graphical model, to generate information which at least partially models at least a part of the financial scenario using information collected by the engine during creation of the graphical model.

At col. 3, lines 45-54, Belcsak et al. provides an overview of the graphical user interface, financial instruments, financial scenarios, instrument information, and parties to an instrument:

The graphical user interface preferably enables the user to create party graphics respectively representing parties to the financial scenario, and to generate financial instrument graphics representing financial instruments, wherein each financial instrument graphic connects two of the party graphics. The party graphics and the financial instrument graphics define the graphical model of the financial scenario. Preferably, the financial instrument graphics indicate a direction of flow, relative to the financial instrument represented thereby, between the parties connected by the financial instrument graphic.

Belcsak et al. discusses the tool and user interface in detail, often referring to the lender-borrower or lessor-lessee scenarios. Within 70 columns of disclosure, Belcsak et al. mentions "merger" and "acquisition" once:

*** The system also provides canned calculations for specific types of financial elements (e.g. rent, loans, etc.). These canned calculations cover a very large fraction of the payments users would run into when modeling a financial scenario. Thus, users will spend little time having to invent new payment mechanisms. In addition, this set of canned calculations is contained in an expandable library, so as the industry changes, additions can be added to the library to keep it up to date. *** In addition to general financial instruments, the system may also include instruments for advanced corporate finance operations, such as mergers, acquisitions and the like. Col. 11, lines 37 to 62. (underline added)

The reference to mergers and acquisitions in Belcsak et al. is to demonstrate that a library of calculations may include calculations that pertain to a corporate finance operation, such as an acquisition. For example, a finance operation for an acquisition may utilize a calculation from the library of calculations. It is important that this paragraph, specifically the last sentence, be understood correctly and in the context of the Belcsak et al. disclosure.

The paragraph does not teach or suggest selecting between a merger and an acquisition. Belcsak et al. never mentions that the tool is or can be used to select one

business structure over another, such as a merger over an acquisition, and indeed provides no motivation to modify itself to obtain the invention claimed in claims 1, 18, or 32.

Referring now to the present application, the independent claims all include a "selecting" limitation. For example, the selecting limitation of claim 1 provides:

A method of preparing and evaluating a business proposal, comprising the steps of:

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*
*

selecting at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture . . .

Claim 1 thus includes selecting at least two structures from an alliance, an acquisition, an equity venture, a partnership, and a venture.

The final Office Action refers to Belcsak et al. at col. 1, lines 22-30 and states that "Belcsak et al. discloses that the invention is directed to a modeling tool that analyzes various aspects of a *proposed* financial arrangement between parties to the transaction and *structures* the financial proposals in an optimal manner." (emphasis added in Office Action) First, this reference rearranges the text of Belcsak et al. and is not accurate. Second, although the words "proposed" and "structures" are both italicized (again, emphasis added in the Office Action), they do not go together in the sense of "proposed structures." Belcsak et al. does not disclose alternative business structures. (Indeed, "structures" is used as a verb in the cited sentence.) In addition, "proposed" refers to financial arrangements, not business structures. The cited text

makes no mention of business structures. We respectfully assert that the reliance on col. 1, lines 22-30 to show a teaching or suggestion of selecting a business structure such as an alliance, acquisition, equity venture, partnership, and venture is clearly erroneous.

Next, the Office Action refers (in combination) to col. 4, lines 29-37 and col. 11, lines 59-62 and states that “a financial instrument is disclosed as encompassing advanced corporate finance operations . . .” We respectfully assert that combining these two sections does not provide the purported result and doing so misrepresents Belcsak et al.

Belcsak et al. does not state that an advanced corporate finance operation is a financial instrument. Belcsak et al. states that the system includes instruments for advanced corporate finance operations. No where, however, does Belcsak et al. state that mergers and acquisitions are financial instruments. Although it makes sense to state that a corporate operation may include one, several, or many financial instruments, it does not make sense to state that a corporate operation is a financial instrument. We respectfully assert that the purported definition of “financial instrument” is clearly erroneous. We also note that neither section referred to in the Office Action mentions selecting or ranking alternative business structures.

Next, the Office Action refers to Figure 3 and states that a process is illustrated “in which a user has the option to add more instruments before creating the proposed financial model.” Figure 3 shows that “Another Party or Instrument” can be added before a model is created. Adding a party or instrument is not selecting. Figure 3 has nothing to do with selecting a business structure. We respectfully assert that Figure 3

does not teach or suggest selecting a business structure such as an alliance, acquisition, equity venture, partnership, and venture.

We note that independent claim 18 also recites a "selecting" step:

selecting at least two alternative structures . . . selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture

As does independent claim 32:

a computer program residing in said computer or in said memory, wherein the proposal [being evaluated] includes a plurality of alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture

In addition to reciting "selecting" at least two alternative structures, claim 1 recites "ranking" the structures:

ranking the at least two alternative structures based on the evaluation of the stored information

We assert that the ranking element is neither anticipated by nor obvious in view of Belcsak et al. In fact, the Office Action states that "Belcsak et al. does not expressly disclose ranking the two alternative structures", but goes on to state that "the optimization engine, in essence, must perform some type of internal ranking in order to determine which scenarios provide the best deal to the user." This assertion is flawed for at least two reasons: (1) the "scenarios" of Belcsak et al. correspond to the terms of a financial instrument, not to alternative business structures, and (2) optimizing does not equate to ranking.

Claim 1 also recites "outputting a report displaying the rankings." The Office Action states that it would have been obvious to modify Belcsak et al. to display

rankings of the alternative structures. Thus, the Office Action makes three leaps to go from a tool that models a financial scenario to one that displays rankings of alternative business structures. According to the Office Action, (a) modeling a financial scenario encompasses selecting a business structure, (b) optimizing is the same as ranking, and (c) providing visual rankings is the next obvious step in light of (a) and (b). We respectfully assert that Belcsak et al. does not disclose or make obvious any one or combination of (a), (b), and (c) of claim 1.

We note that independent claim 18 recites "calculating an advantage of the structures", which corresponds to ranking the structures of claim 1. Independent claim 32 recites "calculating and generating an output for evaluating the plurality of structures" which corresponds to ranking the structures and outputting a report.

Accordingly, we respectfully assert that the rejections to the pending claims are based upon a clearly erroneous analysis of Belcsak et al. In addition, we assert that it would be clearly erroneous to conclude that Belcsak et al. teaches or suggests modifying itself for use to select a business structure. Further, we assert that Belcsak et al. does not teach or suggest that optimizing includes ranking. In addition, we assert that outputting a report that ranks business structures is not an obvious extension of Belcsak et al. We request that these errors be reviewed, the rejections withdrawn, and the claims allowed.

Dependent claims 3, 4, 7, 8, 12-17, 22-26, 28-35, and 37-58 each depend on one of the independent claims and are therefore are also believed to be allowable.

Respectfully submitted,



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Dated: April 25, 2007

VIII. CLAIMS APPENDIX

1. A method of preparing and evaluating a business proposal, comprising the steps of:

displaying a plurality of questions relating to the proposal, including proposal components, proposal characteristics, risks, revenue drivers, investment bases, and a business environment;

allowing access to a database of client information and a database of proposer information;

receiving answers to the plurality of questions based on information accessed in the databases;

defining a query for search criteria for the proposal;

performing a search based on the query and answers to the questions;

storing information relevant to the proposal gathered in the search;

selecting at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture;

evaluating the stored information by computer;

ranking the at least two alternative structures based on the evaluation of the stored information;

outputting a report displaying the rankings and responses to at least one of the questions;

reevaluating information sources and a business environment relative to the proposal;

reevaluating organizational and proposal considerations, and risks relative to the proposal;

reconsidering at least one of the alternative structures and optionally reshaping at least one of the alternative structures; and

reevaluating and re-ranking the at least two alternative structures.

3. The method of Claim 1, wherein the step of displaying a plurality of questions comprises displaying predetermined questions on at least one template stored in a computer and wherein the step of receiving the answers to at least one predetermined question calls up for display at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal.

4. The method of Claim 1, wherein the proposals are evaluated by calculating at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value.

7. The method of Claim 1, further comprising displaying the rankings with a graphical user interface.

8. The method of Claim 7, wherein the rankings are presented in a Harvey-ball format.

12. The method of Claim 1, wherein the answers are input to the computer through a graphical user interface by choosing selections from at least one of a drop-down screen, a scroll screen, a check box, and a list box.

13. The method of Claim 12, wherein the graphical user interface uses a technique selected from the group consisting of a drop-down selector screen, a scroll screen, and a check box.

14. The method of Claim 1, wherein the proposal comprises an offer of a service from the provider, and further comprising the step of calculating a way to pay for the proposal.

15. The method of Claim 1, wherein the structures are ranked by displaying a numerical output.

16. The method of Claim 1, wherein the answers are provided through a graphical user interface, and the input is in a form of brief numerical or pseudo-numerical inputs.

17. The method of Claim 1, wherein an output is provided through a graphical user interface, and the output is in a form of brief numerical or pseudo-numerical outputs.

18. A method of preparing and evaluating a business proposal, comprising:
displaying a plurality of questions relating to the proposal, including proposal components, proposal characteristics, risks, revenue drivers, investment bases, and a business environment;

allowing access to a database of client information and a database of proposal information;

receiving answers to the plurality of questions based on information accessed in the databases;

defining a query for search criteria for the proposal;

performing a search based on the query and answers to the questions;

searching at least one database for information concerning a business partner, the proposal and the business environment, wherein the information includes cost drivers, the revenue drivers, markets served, risks of the proposal, and customers served;

providing financial data concerning the proposal to a computer, wherein the financial data includes revenue elements of the proposal, a cost of the proposal, and an innovation value of the proposal;

proposing at least two alternative structures between a provider and a purchaser for the business proposal, using said financial data and the answers, a result of the search, and information from the databases, wherein the structures are selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture;

calculating an advantage of the structures based on the answers, the result of the search, the information from the databases and the provided financial data, wherein the advantage is calculated based on the cost, a rate of return, an assessment of potential future benefits, and a revenue stream;

reshaping at least one of the two alternative structures based on the calculated advantage; and

recalculating the advantage of the structures based on the reshaping.

22. The method of Claim 18, further comprising a step of entering information concerning strength of a business relationship by entering a number from 1 to 5, and wherein the step of calculating the advantage of the structures is based on the entered information concerning the strength of a business relationship.

23. The method of Claim 18, wherein the plurality of questions is entered through at least one template stored in the computer.

24. The method of Claim 23, wherein the plurality of questions entered through at least one template calls up at least one template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal.

25. The method of Claim 18, wherein the advantage is calculated as at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value.

26. The method of Claim 18, wherein the advantage is calculated as at least one revenue stream and includes at least one example of how to pay for the proposal.

28. The method of Claim 18, wherein the advantage is recalculated by a step of entering updated data into the computer.

29. The method of Claim 18, wherein the step of searching comprises a search of at least one Internet site, and further comprising the steps of updating the search periodically, and updating the computer calculation of an advantage periodically.

30. The method of Claim 18, wherein the answers are provided through a graphical user interface.

31. The method of Claim 18, further comprising a step of providing an output through a graphical user interface.

32. A computer system for evaluating a proposal, comprising:
a computer processor;
at least one memory operably connected to said computer, said memory containing data relevant to the proposal, wherein the data comprises revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, a cost of the proposal, methods of achievement of the proposal, and an innovation value of the proposal; and
a computer program residing in said computer or in said memory, wherein the proposal includes a plurality of alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture, and the computer program is configured for:
displaying a plurality of questions relating to the proposal, including proposal components, proposal characteristics, risks, revenue drivers, investment bases, and a business environment;
allowing access to a database of client information and a database of proposer information;
receiving answers to the plurality of questions based on information accessed in the database;
calculating and generating an output for evaluating the plurality of structures based on the cost, a rate of return, an assessment of potential future benefits, and a revenue stream, and also for accepting changes to at least one of the plurality of

alternative structures and recalculating and regenerating an amended output evaluating the plurality of alternative structures including the at least one changed structure.

33. The computer system of Claim 32, wherein the computer program is configured for generating a graphical user interface for at least one of inputting or outputting information.

34. The computer system of Claim 32 wherein the computer program output is a series of numerical ratings from 1 to 5.

35. The computer system of Claim 32 wherein the computer program further comprises at least one template of predetermined questions for displaying the plurality of questions, and the computer program uses the answers to said questions to evaluate the proposal.

36. The computer system of Claim 35 wherein the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer program is configured to evaluate the proposal based on the answers to said questions.

37. The computer system of Claim 32 wherein the output is a series of Harvey balls.

38. The computer system of Claim 32, wherein the computer program uses a technique of control-action-response in seeking and inputting information from a user of the computer system.

39. The method of Claim 1, wherein the alternative structures between the purchaser and the provider differ in an amount of equity owned by the purchaser and the provider.

40. The method of Claim 1, wherein an advantage of at least one of the structures is creation of an asset.

41. The method of Claim 1, wherein the provider furnishes information to the purchaser demonstrating a difference in value to the purchaser based on the alternative structures.

42. The method of Claim 1 wherein at least one of cost drivers and revenue drivers is used to evaluate and rank the structures.

43. The method of Claim 1, wherein evaluations of the at least two alternative structures are calculated as revenue streams to the purchaser.

44. The method of Claim 1, wherein evaluations of the at least two structures are calculated as at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value.

45. The method of Claim 18, wherein the provider is a service provider and the advantages of the structures are calculated as a revenue stream to the purchaser.

46. The method of Claim 18, wherein the alternative structures differ in an amount of equity owned by the purchaser and the provider.

47. The method of Claim 18, wherein an advantage of at least one of the structures is creation of an asset.

48. The method of Claim 18, wherein at least one of cost drivers and revenue drivers is used to calculate the advantages for the structures.

49. The method of Claim 1, wherein after the step of evaluating the stored information, a comparison is made with other search reports or results.

50. The method of Claim 1, wherein after the step of evaluating the stored information, additional deal considerations are considered.

51. The method of Claim 1, wherein after the step of evaluating the stored information, a user seeks additional information about risks or mitigates the risks.

52. The method of Claim 1, further comprising seeking additional information about a business environment after the step of evaluating the stored information.

53. The method of Claim 1, further comprising reshaping at least one of the alternative structures based on revenue streams.

54. The method of Claim 1, further comprising periodically updating information and reevaluating the at least two alternative structures.

55. The method of Claim 18, wherein after the step of recalculating, additional deal considerations are considered.

56. The method of Claim 18, wherein after the step of recalculating, a user seeks additional information about risks or mitigates the risks.

57. The computer system of Claim 32, wherein the computer program is configured for periodically updating and storing business environmental information.

58. The computer system of Claim 32, wherein the computer program is configured for searching internal and external databases.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.